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In re Application of:  
KEMP, Stephen, J., et al. : DECISION ON PETITION UNDER  
U.S. Application No.: 10/538,664 : 37 CFR 1.47(a)  
PCT No.: PCT/GB2002/005588 :  
International Filing Date: 10 December 2002 :  
Priority Date: None :  
Attorney's Docket No.: 86769-0020 :  
For: DATA MODEL DEVELOPMENT  
TOOL :  
:

This decision is issued in response to applicants' Petition Under 37 CFR 1.47(a), filed 14 November 2006. Applicants have submitted the required petition fee.

**BACKGROUND**

On 10 December 2002, applicants filed international application PCT/GB2002/005588. The international application did not claim an earlier priority date, and it designated the United States. On 24 June 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 10 June 2005.

On 10 June 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 14 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date was required.

On 14 November 2006, applicants filed a response to the Notification Of Missing Requirements, with required five-month extension fee. The submission includes the required surcharge payment and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signatures of two of the inventors (Stephen J. KEMP and Daivd HILLEWAERE), whom applicants assert have refused to execute the application or cannot be located after diligent effort.

## DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor(s); (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor(s); and (4) factual proof that the inventor(s) refuse to execute the application or cannot be reached after diligent effort.

Applicants here have paid the required petition fee. Item (1) is therefore satisfied.

With regard to item (2), the petition provides the last known address for one of the non-signing inventors, Stephen J. KEMP. However, the petition only provides a business address for the second non-signing inventor, David HILLEWAERE. The last known home address for this inventor is required (see MPEP section 605.03). Accordingly, item (2) is not satisfied with respect to inventor David HILLEWAERE.

Regarding item (3), section 409.03(a) of the MPEP states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed declarations executed by two of the named inventors; however, each of these declarations is defective. The declaration executed by Wim DECRAENE includes only page one and page three; the second page is missing. This incomplete two-page declaration is defective for failure to include all required language and for failure to identify all the inventors herein. Applicants must provide a complete copy of the declaration executed by Wim DECRAENE, with such declaration complying with the requirements of 37 CFR 1.497 and including unsigned signature blocks for both of the non-signing inventors.

With respect to the second executed declaration, all three pages are included; however, the signing inventor has changed her name from her name of record, Katherine A. MATHER, to Katherine A. NICHOLSON. The declaration is therefore defective for failure to properly identify the inventors of record herein (and for failure to initial the handwritten modification of the name on the declaration). If this inventors name has changed since the filing of the international application, a petition under 37 CFR 1.182 is required; see MPEP Section 605.04(b):

Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 35 U.S.C. 1.182 together with an appropriate petition fee.

In this case, the change from MATHER to NICHOLSON is more than a mere typographical error or a phonetic misspelling of the applicant's name. Accordingly, a grantable

petition under 37 CFR 1.182 to correct the name of this inventor is required before the declaration can be accepted. For such a petition to be grantable, MPEP § 605.04(c) states that "the petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order."

Based on the above, applicants have not provided acceptable declarations executed by the cooperating inventors on their own behalf and on behalf of the non-signing inventors. Item (3) is therefore not satisfied.

Regarding item (4), applicants state that the non-signing inventors refuse to execute the application or cannot be located after diligent effort. With respect to the inability to locate an inventor, MPEP section 409.03(d) states the following:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein.

Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

In the alternative, where it is asserted that the inventor refuses to sign the application, MPEP section 409.03(d) states that "[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, applicants have provided a declaration from David D. Nelson, with supporting documents, as evidence of the efforts made to obtain the signature of the non-signing inventors.

These materials refer to emails sent to the inventors by a Melissa Garrison, and to Federal Express packages subsequently sent to the two non-signing inventors by a Celine Jiminez Crowson. The accompanying exhibits indicate that the Federal Express package directed to Mr. KEMP at his home address was received and apparently signed for by the inventor; the second Federal Express package was directed to Mr. HILLEWAERE at a business address, and was signed for by a person named S. Maiolo.

These materials are not sufficient to demonstrate that the non-signing inventors have refused to execute the application or cannot be located after diligent effort. With respect to Mr. KEMP, applicants have not provided an adequate showing that the inventor was provided with a copy of the complete application papers (including specification, claims, and drawings), as required before a refusal to sign can be claimed. The statement of Mr. Nelson asserts that copies of the application as filed were included with the Federal Express package delivered to Mr. KEMP; however, the attached cover letter refers only to an enclosed declaration and assignment documents, and Mr. Nelson (who did not sign the letter) does not appear to have the required firsthand knowledge to confirm what was enclosed with such letter. A statement from Ms. Crowson, who signed the cover letter, is required to confirm that the complete application was included with this mailing or, if the application documents were not included, evidence that these materials have subsequently been forwarded to this inventor at his last known address are required. In addition, it is noted that the present petition was filed only two weeks after the request for signature was delivered to the inventor. Any subsequent submission herein should include a statement regarding whether any response has been received from the inventor in the time since the original petition was filed.

As for Mr. HILLEWAERE, applicants have provided no evidence to confirm any communications with this inventor. The Federal Express package was delivered to a business address, and signed for by a third party. From this submission, it cannot be confirmed that the inventor received the Federal Express.<sup>1</sup> In addition, applicants have not provided any evidence that a diligent effort has been made to locate a current home address for this inventor and deliver a request for signature, with a copy of the complete application papers, to such address (i.e., firsthand evidence, with documentary support, of internet searches and other inquiries made to locate the inventor). Absent such a showing, it cannot be concluded that this inventor cannot be located after diligent effort.

Based on the above, item (4) is not satisfied with respect to either non-signing inventor.

### CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)"

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<sup>1</sup> Even if received, this Federal Express delivery has the same deficiency concerning the presence of the complete application papers as discussed above with respect to Mr. KEMP.

and must include the materials required to satisfy items (2), (3) and (4) of a grantable petition, as discussed above and in the MPEP.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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